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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050685
Party	Plaintiff Renee Shatanoff
Correspondence Address	Strategic Legal Counseling Attn: Louis F. Teran 1055 East Colorado Blvd. , Suite 500 Pasadena, CA 91106 UNITED STATES lteran@strategiclegalcounseling.com
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Date	09/08/2009
Attachments	Repsonse to Registrant Motion RE Rule 26 disclosure.pdf ( 7 pages )(74493 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark  
Registration No. 3468426  
Cancellation No. 92050685  
Registered: July 15, 2008  
Mark: IGNITING BUSINESS  
International Class: 35

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RENEE SHATANOFF,		)
		)
Petitioner		)
		)
v.		)
		)
EXECUTIVE DEVELOPMENT		)
ARCHITECTS LLC,		)
		)
Registrant.		)
		)
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**PETITIONER’S RESPONSE TO REGISTRANT’S MOTION TO  
ACCEPT RULE 26 DISCLOSURES AS PREVIOUSLY FILED WITH  
REGISTRANT’S MOTION FOR SUMMARY JUDGMENT**

Renee Shatanoff (“Petitioner”), by and through its attorney, hereby moves the Trademark Trial and Appeal Board (“TTAB”) for an Order dismissing Registrant’s Motion To Accept Rule 26 Disclosures As Previously Filed With Registrant’s Motion For Summary Judgment.

Petitioner hereby also moves for sanctions for Registrant’s failure to participate in the required Discovery Conference and failure to make Initial Disclosures.

## **I. INTRODUCTION**

On March 17, 2009, Petitioner filed a Petition for Partial Cancellation of Registrant's Mark. Trial dates were set with the Deadline for Discovery Conference set for May 26, 2009 and Initial Disclosures being due by June 25, 2009. After Registrant submitted its Answer, Petitioner's attorney left several voicemails in several attempts to reach Registrant's attorney to schedule the required Discovery Conference. Thereafter, Registrant's attorney left a voicemail for Petitioner's attorney that clearly and expressly indicated a refusal to participate in any discovery conference and a plan to file for summary judgment.

On May 22, 2009, days before the Deadline for Discovery Conference, Registrant filed its Motion for Summary Judgment. Registrant willfully refused to participate in the Discovery Conference and failed to submit its Initial Disclosures prior to filing its Motion for Summary Judgment, raising thereby the prospect that Registrant is not in good faith.

## **II. ARGUMENT**

### **A. The Parties Never Agreed to Forego Filing Initial Disclosures**

Contrary to Registrant's statements in its Motion dated August 31, 2009, the Parties never agreed to forego filing of initial disclosures. Registrant uses the precedent Opinion of the TTAB in *Boston Red Sox Baseball Club Limited Partnership v. Harry F. Chaveriat III*, Opposition No. 91182083, (hereinafter Red Sox Case), to support its Argument that "the Parties tacitly mutually agreed to forego filing initial disclosures."

However, Registrant fails to mention that in the Red Sox Case, "immediately following the parties' discovery and settlement conference, opposer filed a consented 'Notice of Waiver of Initial Disclosures,' wherein the parties agreed to 'waive any requirement to make initial disclosures...'"

In this case, Registrant willfully refused to participate in any discovery conference, the parties never discussed the option of foregoing initial disclosures, and neither party ever filed a “Notice of Waiver of Initial Disclosure.” As such, the parties never agreed to forego initial disclosures.

**B. Initial Disclosures Were Never Made By Registrant Prior To Its Move For Summary Judgment.**

As stated by Registrant in its Motion dated August 31, 2009, “albeit not labeled as such, Registrant’s Motion for Summary Judgment included its initial disclosures.” Registrant’s initial disclosures were never submitted “prior” to its Motion for Summary Judgment.

Trademark Rule 2.127(e)(1) clearly states that “a party may not file a motion for summary judgment until the party has made its initial disclosures.” Registrant never submitted its initial disclosure prior to its Motion for Summary Judgment. The attachments incorporated by reference with Registrant’s Motion for Summary Judgment lacked some of the information required by proper initial disclosures. But even if the attachments incorporated by reference with Registrant’s Motion for Summary Judgment are considered to be proper initial disclosures, they were submitted with the Motion not prior. As such, initial disclosures were never made by Registrant prior to its move for summary judgment.

**C. With Its Motion For Summary Judgment, Registrant Significantly Interfered With The Judicial Process.**

The failure to participate in the discovery conference and to make initial disclosures halts and stymies the rest of the cancellation proceeding and interferes with the judicial process. The requirement for parties to participate in a discovery conference and to make initial disclosures was introduced into the Board inter partes proceeding by amendments to the Trademark Rules. *See Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242 (Aug. 1, 2007), (hereinafter “Final Rule”). In the Final Rule, the

Board indicated that the requirement for initial disclosures facilitates the exchange of “core information regarding the existence of and location of witnesses and documents,” lessens the expense of traditional discovery, and promotes early communication toward possible settlement. Furthermore, in the Final Rule, the Board indicated that “even if parties do not settle the case, disclosure will promote more efficient discovery and trial, reduce incidents of unfair surprise, and increase likelihood of fair disposition of the parties’ claims and defenses.”

By refusing to participate in the discovery conference and not submitting initial disclosures, Registrant willfully thwarted the Board’s attempt to make these proceedings smoother, more efficient and orderly, through rule changes, and the Board should determine that Registrant’s acts and omissions significantly interfere with the judicial process.

**D. Granting the Registrant’s Motion Will Cause Prejudice To Petitioner.**

In the Final Rule, the Board indicated that “the specificity of information parties will provide to comply with initial disclosure obligations is one of the issues that must be anticipated and discussed by the parties during their discovery conference.” Registrant willfully refused to participate in the discovery conference; therefore, the specificity of information for initial disclosure was never discussed. Registrant never submitted timely and proper initial disclosures.

The attachments submitted by Registrant with its Motion for Summary Judgment are deficient of the minimum requirements for initial disclosures. Firstly, said attachments do not clearly identify the names of potential witnesses or the discoverable information that each potential witness may have. Secondly, said attachments do not clearly identify the documents that Registrant may use to support a claim or defense. Thirdly, said attachments fail to indicate the computation of damages claimed. Finally, said attachments fail to indicate any insurance agreements that may be applicable to this matter.

As such, Petitioner was forced to answer the Motion for Summary Judgment lacking the information that could or should have derived from a discovery conference and initial disclosure. Such information was required, but has not been supplied. In addition to the prejudice caused by this failure, Petitioner suffers prejudice caused by expense and delay.

Because Registrant has not participated in the discovery conference or made initial disclosures, Petitioner was forced to spend more time and money in responding to both Registrant's Motion for Summary Judgment and Motion dated August 31, 2009. Registrant's non-compliance has already prolonged this litigation.

The Board should determine that Petitioner has been prejudiced by Registrant's failures.

**E. The Board Should Impose Sanctions For Registrant's Willful Failure To Comply With TTAB Rules.**

Trademark Rule 2.120(g)(1) provides, in pertinent part (emphasis added):

**If a party fails to participate in the required discovery conference, or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure** or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure.

Trademark Rule 2.120(g)(2), which sets forth additional provisions discussing the possible imposition of sanctions for failure to make initial disclosures, states, in pertinent part (emphasis added):

**If a party fails to make required initial disclosures** or expert testimony disclosures, **and** such party or the party's attorney or other authorized representative **informs the party or parties entitled to receive disclosures that required disclosures will not be made**, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

In this case, after repeated requests by Petitioner's attorney for the required discovery conference, Registrant's attorney expressed via voicemail an intention to file for summary judgment and not to participate in any discovery conference. Before the mandated deadline for

discovery conference, Registrant filed its Motion for Summary Judgment without ever participating in the discovery conference and without ever submitting its initial disclosures.

Since Registrant filed its Motion for Summary Judgment before the deadline for a discovery conference and before the deadline for initial disclosures, Petitioner considered these proceedings to have been effectively suspended as of the date of filing of the motion pending its disposition. Therefore, Petitioner did not file any motion to compel.

WHEREFORE, due to Registrant's willful failure to comply with the TTAB Rules, Petitioner prays that the Board dismiss with prejudice Registrant's Motion for Summary Judgment and Registrant's Motion to Accept Rule 26 Disclosures as Previously Filed with Registrant's Motion for Summary Judgment. In addition, Petitioner prays that the Board order Registrant to pay Petitioner's "reasonable expenses, including attorney's fees, caused by this failure..." Fed. R. Civ. P 37(b)(2).

Dated: September 8, 2009

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'L. Teran', with a long horizontal flourish extending to the right.

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Louis F. Teran  
Strategic Legal Counseling  
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Suite #500  
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(818) 484-3217 x200

Attorney for Petitioner Renee Shatanoff.

**CERTIFICATE OF SERVICE**

I, Louis F. Teran, hereby certify that on this 8<sup>th</sup> day of September, 2009, the foregoing **PETITIONER'S RESPONSE TO REGISTRANT'S MOTION TO ACCEPT RULE 26 DISCLOSURES AS PREVIOUSLY FILED WITH REGISTRANT'S MOTION FOR SUMMARY JUDGMENT** was served upon Registrant's counsel of record by depositing same with the U.S. Postal Service, first-class postage prepaid, addressed to Petitioner's counsel address of record as follows:

Leigh Augustine, Esq.  
Sherman & Howard L.L.C.  
633 Seventeenth Street, Suite 3000  
Denver, Colorado 80202

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'L. F. Teran', written over a horizontal line.

Louis F. Teran